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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/800,893 | 03/15/2004 | Ming-Hong Hung | DW0087USNA | 1499 |
| 24199 | 7590 | 04/11/2006 | EXAMINER | |
| DUPONT PERFORMANCE ELASTOMERS L.L.C. PATENT RECORDS CENTER 4417 LANCASTER PIKE, BARLEY MILL PLAZA P25 WILMINGTON, DE 19805 | | | WU, IVES J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1713 | |

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,893

Applicant(s)

HUNG ET AL.

Examiner

Ives Wu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

(1). The Request For Continued Examination (RCE) filed on March 16, 2006 has been received and noted.

However, the rejections of claims 1 ~ 8 in the prior Office Action dated December 14, 2005 remain sustained.

Claim Rejections - 35 USC § 103

(2). The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office Action dated on December 14, 2005.

(3). Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stivers (EP0842980A2) in view of Farnham et al (US005134211A) for the same rationale in the prior Office Action dated on December 14, 2005.

Response to Arguments

Applicant's arguments filed on March 16, 2006 have been fully considered but they are not persuasive.

Applicant's focus arguments apparently reside in the contention that compatibility of polyether with fluoroelastomer is not the reason of being less fugitive such as the examples of polyesters and polyethylene oxides. Then, the result of using a plasticizer having small H atoms in a fluoroelastomer composition is not predictable.

The examiner disagrees with the applicant for the following reasons:

More compatibility is based on the fact that (1). The backbone of polyether disclosed by Farnham et al is close to the backbone of polyether disclosed by Stivers et al (EP 0842980A2), and (2). Just a smaller H atom replacing the fluorine atom to make a polar side group in every repeating unit of Stivers et al would make difference in terms of fugitive from the original polyether of Stivers et al while blending with fluoroelastomer.

Since the motivation has been provided to establish the 103 obviousness, it is the applicant's burden to provide unexpected results to show back-to-back test by using the closest prior art. The showing should be commensurate in scope with the claims.


Art Unit: 1713

Conclusion

This is a continuation of applicant's earlier Application No. 10/800893. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Examiner: Ives Wu
Art Unit: 1713
Date: March 28, 2006


DAVID W. WU
ADVISORY PATENT EXAMINER
BIOLOGY CENTER 1700